Patent Attorney's Docket No. <u>016660-181</u>

## IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re Patent Application of

Wai Hing Lai et al.

Application No.: 10/693,938

Filed: October 28, 2003

For: ELECTRIC GRILL

Group Art Unit: 3742

Examiner: John A. Jeffery

Confirmation No.: 4311

## REQUEST FOR WITHDRAWAL OF THE FINALITY OF THE OFFICE ACTION

Commissioner for Patents P.O. Box 1450 Alexandria, VA 22313-1450

Sir:

Applicants respectfully request that the finality of the Office Action dated November 16, 2004 be withdrawn, as premature.

In the Amendment filed September 22, 2004, original claim 11 was rewritten in independent form, by incorporating the subject matter of original claim 1. The rewriting of claim 11 in independent form did not present any substantive issues that were not previously before the Examiner at the time of the initial examination of the application.

In the most recent Office Action dated November 16, 2004, claims 11 and 12 were rejected on a new ground of rejection, that is based upon a newly-cited reference, Wertheimer et al. U.S. Patent No. 3,714,885. The Office Action was made final, on the grounds that "Applicant's amendment necessitated the new ground(s) of rejection presented in [the] Office action."

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MPEP §706.07(a) states: "second or any subsequent actions on the merits

shall be final *except* where the Examiner introduces a new ground of rejection *not* 

necessitated by amendment of the application by Applicant ..." (emphasis added).

This section goes on to state that a second or subsequent action on the merits "will

not be made final if it includes a rejection, on newly cited art,...of any claim not

amended by Applicant or patent owner in spite of the fact that other claims may have

been amended to require newly cited art."

There has been no showing that the rewriting of claim 11 in independent form

"necessitated" the new ground of rejection based upon the Wertheimer patent. The

presentation of claim 11 in independent form does not raise any new issues that

were not before the Examiner at the time of the first Office Action. Hence, if claims

11 and 12 are properly rejectable on the basis of the Wertheimer patent, such a

rejection should have been set forth in the first Office Action. The failure to do so

precludes the current Office Action from being made final.

Accordingly, Applicants respectfully request that the finality of the Office

Action dated November 19, 2004 be withdrawn as premature.

Respectfully submitted,

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